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### **REMARKS/ARGUMENTS**

The Office action dated October 6, 2003 and the cited references have been carefully considered. Each of the rejections is addressed below.

#### **Status of the Claims**

Claims 1-32 are currently pending. Claims 33-65 are hereby cancelled.

Claims 26-29 are rejected under 35 U.S.C. §112, first paragraph, for lack of enablement. Claims 1-17, 20-25 and 30-32 are rejected under 35 U.S.C. §103(a) as being unpatentable over Inoue et al. (U.S. Patent No. 5,013,800) in view of Costanzi et al. (U.S. Patent No. 5,350,786). Claims 3-5, 7-25 and 30-32 are rejected under 35 U.S.C. §103(a) as being unpatentable over Karrer et al. (U.S. Patent No. 5,792,825). Claims 26-29 are rejected under 35 U.S.C. §103(a) as being unpatentable over Karrer et al. in view of Malik et al. (U.S. Patent No. 5,679,733). The Applicants traverse each of these rejections.

#### **Claim Rejection Under 35 U.S.C. § 112, First Paragraph**

Claims 26-29 are rejected under 35 U.S.C. §112, first paragraph, for lack of enablement. The Office Action states that the specification does not reasonably provide enablement for what is attached to the HALS and where it is attached. Applicants respectfully direct the Examiner's attention to pages 10 and 11 of the specification. Applicants have provided a working example and additional explanation of the incorporation of HALS into Applicants claimed invention.

In reviewing the standard for enablement, Applicants need only disclose enough to enable one of ordinary skill in the art to practice the invention without undue experimentation. As pointed out by the courts, not every last detail of the invention needs to be described in the specification. Further, the law does not require the specification to be a "blueprint" in order to satisfy the enablement requirement. *Stachelin v. Secher*, 24 U.S.P.Q.2d 1513, 1516 (Bd. Pat. App. & Int. 1992).

Applicants have provided sufficient detail and explanation to allow one of ordinary skill in the art to make and use the composition of the claimed invention. In addition, Applicants have provided a working example of the claimed invention, namely a composition comprising a polyorganosiloxane and an admixed sterically hindered amine light stabilizer wherein the polyorganosiloxane is free from alternating cyclic

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hydrocarbon residue. Accordingly, Applicants have complied with the requirements of 35 U.S.C. §112, first paragraph. Applicants respectfully request reconsideration and withdrawal of the rejection.

**Claim Rejection Under 35 U.S.C. § 103(a)**

Claims 1-17, 20-25 and 30-32 are rejected under 35 U.S.C. §103(a) as being unpatentable over Inoue et al. (U.S. Patent No. 5,013,800) in view of Costanzi et al. (U.S. Patent No. 5,350,786). The Office Action states that Inoue discloses a composition comprising a polyorganosiloxane wherein the polyorganosiloxane is free from alternating cyclic hydrocarbon residues and the inclusion of aging retarders and ultraviolet absorbers. The Office Action also states that Costanzi discloses the addition of hindered amine light stabilizers to an alkenyl-containing compound. According to the Office Action, it would have been obvious to one of ordinary skill in the art to combine the hindered amine light stabilizer to the composition of Inoue.

Inoue is directed to various organopolysiloxane-based compositions to provide reduced surface stain and contains an organopolysiloxane block copolymer, which contains either phenyl groups or fluorine-containing groups. Inoue does not teach or even suggest, the polyorganosiloxane of the present invention. Further, Inoue provides that optional components including pigments, ultraviolet absorbers, aging retarders, and the like may be added in limited amounts. Inoue does not provide additional information on the types of such aging retarders, or the amounts, or possible ways of mixing such with its organopolysiloxane.

Costanzi does not correct the deficiencies of Inoue. Costanzi is directed to the incorporation of HALS into a reaction mixture during copolymerization of  $\alpha$ -olefins or of their mixtures with other unsaturated monomers. Specifically, Costanzi defines the certain olefinic monomers suitable in that invention at column 10, lines 17-30. Costanzi does not teach or even describe the use of HALS with polyorganosiloxane. One of ordinary skill in the art would not look to Costanzi as providing any relevant information to improve upon Inoue. Further, chemistry is an unpredictable art. In the instant case, the Examiner is trying to combine two patents that do not even mention similar chemistries or solutions to similar problems. It is improper for the Office to use the Applicants' present invention for motivation to look backward into the art combine references.

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Nothing in Costanzi or Inoue even remotely suggests that the two could be combined. A pursuit of such curiosity would require undue experimentation and is not routine.

Accordingly, Applicants respectfully request reconsideration and withdrawal of the rejection.

Claims 3-5, 7-25 and 30-32 are rejected under 35 U.S.C. §103(a) as being unpatentable over Karrer et al. (U.S. Patent No. 5,792,825). Claims 26-29 are rejected under 35 U.S.C. §103(a) as being unpatentable over Karrer et al. in view of Malik et al. (U.S. Patent No. 5,679,733). The Office Action states that Karrer discloses a composition of polyorganosiloxane and a sterically hindered amine light stabilizer. The Office Action further notes that Karrer does not disclose the claimed mole percentages, or the amounts or types of fillers. However, the Office Action states that it would have been obvious to one of ordinary skill in the art to add the instantly claimed amounts through routine experimentation and that the art is replete with various types of fillers.

Regarding Malik, the Office Action states that Malik discloses the instantly claimed HALS structure (of Claims 26-29) as being commercially available and therefore it would have been obvious to have substituted the HALS of Malik into the composition of Karrer.

Contrary to the Office Action's position, Karrer does not disclose the instant invention, namely a composition comprising a polyorganosiloxane and an admixed sterically hindered amine light stabilizer wherein the polyorganosiloxane is free from alternating cyclic hydrocarbon residue. Karrer is directed to a compound of polyorganosiloxane having a tertiary cyclic amine functional group bonded to the silicone via a cyclic acetal group. Thus, Karrer requires a cyclic acetal between the polyorganosiloxane and the tertiary cyclic amine functional group. Applicants' claimed invention, i.e. composition, is clearly different than that of Karrer.

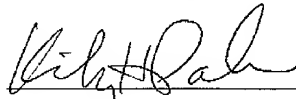
Regarding Claims 26-29, Malik does not correct the deficiencies of Karrer. Karrer, at column 1, lines 28-37, describes a 2,2,6,6-tetramethylpiperidines and then describes the deficiencies of such stabilizers. Karrer describes that the addition of a sterically hindered cyclic amine functional group, bonded via a cyclic acetal group provided certain advantages. Malik simply describes a solid solution of low molecular weight and high molecular weight 2,2,6,6-tetraalkylpiperidinyll compounds. The two

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references, alone or in combination, do not teach or suggest Applicants' claimed invention. Applicants respectfully request reconsideration and withdrawal of these rejections.

Applicants respectfully submit that all claims as presented are allowable, and requests prompt issuance of a Notice of Allowance. In order to expedite the issuance of the application, should the Examiner have any questions, he is encouraged to contact the undersigned at the telephone number below.

Respectfully submitted,



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